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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/595,812

05/12/2006

Paolo Catelli

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SCARBOROUGH STATION

SCARBOROUGH, NY 10510-9227

EXAMINER

MACKEY, JAMES P

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

06/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/595,812 | | CATELLI, PAOLO | |
| | Examiner | | Art Unit | |
| | James Mackey | | 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Specification

The abstract of the disclosure is objected to because of the inclusion of the legal phraseology "said" on lines 8, 10 and 12. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 3 is objected to because of the following informalities: on line 1 of claim 3, "int hat" should be --in that--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, "and two lower recesses" is repeated; lines 5-6, "the end flanges" and "the two embossing rolls" lacks proper antecedent basis in the claim; line 6, "the sides" is unclear as to which of the four sides is intended; line 6, "the same structure" is unclear and should apparently be --said structure-- for clarity; line 7, "handling means" is indefinite in that no function is recited for the means and therefore the scope of the means cannot be ascertained; line 12, "said sides" is unclear as to which of the four sides is intended.

In claim 2, line 2, “it” is unclear as to exactly which structure is intended; line 2, “handling means” is unclear as to how this relates to the handling means recited in claim 1, and is further indefinite in that no function is recited for the means and therefore the scope of the means cannot be ascertained; and lines 3-5, “two having”, “the third one having” and “the other two” are unclear as to what structure is intended (it is suggested that the phrases be changed to --two of said driving shafts having--, --the third said driving shaft--, and --the other two of said driving shafts--).

In claim 3, lines 2 and 3, “axis” should be --axes-- since plural axes are recited.

In claim 4, line 2, “them” is indefinite as to exactly what structure is intended; and line 3, “said hinges” lacks proper antecedent basis in the claim (it appears that claim 4 should depend from claim 3; however, such a claim would be identical to claim 8).

In claim 5, line 2, “it” is indefinite as to exactly what structure is intended; and line 3, “the same fixed sides” is unclear and should apparently be --said fixed sides--.

In claim 7, line 2, “it” and “they” are indefinite as to exactly what structures are intended.

In claim 8, line 2, “them” is indefinite as to exactly what structure is intended.

Allowable Subject Matter

Claims 1-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The prior art of record does not teach or fairly suggest a convertible embossing device comprising a structure having two fixed sides and two mobile sides with

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respective external and internal faces, the internal faces provided with, in correspondence of the respective internal faces, two upper recesses and two lower recesses with a circle-arc profile for supporting end flanges of two embossing rolls, wherein in a first operating position the mobile sides are joined to the fixed sides and the respective upper and lower recesses cooperate with one another to define two pairs of circular seats for said end flanges of said rolls, and in a second operation position, the mobile sides are distanced from the fixed sides and the upper recesses each define, in cooperation with corresponding semicircular closure flanges, two pairs of circular seats for said end flanges of said rolls, as claimed in claim 1.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Mackey/
Primary Examiner
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jpm
June 9, 2008